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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 25

Application Number: 09/607313

Filing Date: June 28, 2000

Appellant(s): Brad Baker

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Deborah Peacock

For Appellant

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**EXAMINER'S ANSWER**

This is in response to the appeal brief filed Dec. 3, 2002.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is incorrect because no amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

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The appellant's statement of the issues in the brief is substantially correct. The correction is whether 29 is supported by the original disclosure under 35 U.S.C. 112 first paragraph, not whether 29 is indefinite by failing to comply with 35 U.S.C 112. Claim 29 was not rejected for being indefinite.

**(7) *Grouping of Claims***

Grouping of claims is not applicable in the instant application because there is only one claim under appealed.

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

“Paint Pop”, distributed by B.I.P Holland B.V., 1996.

4,547,926	Kern	10-1985
5,960,949	Gramlich	10-1999

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claim 29 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 29 recites the limitation “ a paint brush holder attached to said container”; this limitation is not supported by the original disclosure and the drawings. The drawings do not show a paint brush holder attached to the container. The paint brush is attached to the container by packaging; page 11 of the

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specification discloses “ the brush and can are connectable through packaging such as shrink-wrap, adhesive or other packaging”. There is no disclosure or showing of a separate “paint brush holder attached to the container”.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over the brochure on “ Paint Pop” in view of Kern, and Gramlich.

The brochure discloses Paint Pop which comprises candy in the shape of a paint roller, a packet comprising candy powder and a paint tray. The candy powder is emptied into the paint tray and the candy is rolled in the paint tray for consumption. The candy has a non-edible handle portion an edible portion attached to the handle.

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The Paint Pop differs from the claimed product in that it is consisted of a tray and a roller, not a can and a paint brush as claimed. The tray of the Paint Pop does not have a lid.

Gramlich discloses a wet paint and roller storage unit in which the tray has a lid so that the painter does not have to transfer the paint back into the can when he/she stops. When the painter wants to resume painting, he/she will merely have to open the lid and resume painting. (See col. 3)

Kern discloses a roller tray with cover thereon for protecting material in the tray against drying out so that the cover may be hinged open for a painting shift and may be hinged closed on the tray between shifts to avoid drying out of the material in the tray. (See col.1 lines 55-61)

The claimed product only differs from the prior art product in the shape. Applicant is only moving from one conventional design shape to another conventional design shape. A paint tray, a paint can, a paint brush and a pain roller are all conventional shapes. To change from one conventional shape to another conventional shape would have been obvious to one skilled in the art. As to the inclusion of a lid, it would have been obvious for one to include a lid on the paint tray of the Paint Pop product in accordance with the teaching the prior art to Gramlich and Kern. Gramlich and Kern teach to include a lid on a paint tray so that the material in the tray will not dry out and that the painter does not have to transfer the paint back to the can when he/she temporarily stops painting. The Paint Pop is an adaption of a real inedible product into an edible product to provide novelty. Thus, it would have been obvious to one skilled in the art to also adopt the teaching of Gramlich and Kern to provide a parallel function to a painter. The lid will enable the consumer to protect the roller candy and the powder candy from drying out or spilling when the consumer wants to take a break from eating and he/she can simply open the lid when consumption is resumed. The lid will also protect the roller and powder packet from falling out before consumption. With respect to the limitation of “a paint

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brush holder attached to the container”, it is not clear what this structure is because there is no disclosure of a separate holder or a showing of a separate holder in the specification. The specification discloses the brush and can are connected through packaging. The paint roller in the Paint Pop product is located in the tray and the whole product is package; thus, the Paint Pop product does have a holder for the paint roller.

**(11) Response to Argument**

On page 7 of the appeal brief, appellant argues the examiner is in error as to the disclosure of a paintbrush holder in the specification; appellant states the examiner truncated the sentence on Page 11 of the specification. The examiner respectfully disagrees with appellant that the 112 first paragraph rejection is an error. Even if the sentence on page 11 is not truncated, it still does not describe a paint brush holder. The exact text of page 11 lines 19-21 is as followed “ as shown in Fig. 14 c, which comprises a finite length cylinder 80 connected to a finite length hollow tube section having a substantially rectangular cross section 82. The packaging 78, as shown in Fig. 14c, cooperatively receives can 18 and brush 10.” It is not seen how appellant views this disclosure as unequivocally disclosing a paintbrush holder. It is no where disclosed that cylinder 80 or hollow tube 82 is the paint brush holder. The specification discloses packaging 78 cooperatively receives can 18 and brush 10; there is no disclosure of a paint brush holder attached to the can. Appellant states the examiner is flatly wrong in the statement that there is no disclosure or showing of a paintbrush holder attached to the container. The examiner respectfully disagrees with appellant on this statement. Appellant’s attention is directed to page 8 line 16 where it is disclosed “ Fig. 14c is a top view of a brush and paint can assembly piece of the present invention”; thus, the cylinder 80 and hollow tube 82 that appellant refers to are the top view of the paint can and the brush and not a paintbrush holder attached to the container. Therefore, if appellant relies on figure 14c for support of the limitation of “ a paintbrush holder

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attached to the container”, the brief description of the drawing on page 8 line 16 and the disclosure on page 11 do not support such limitation. The argument made in the second paragraph of page 7 is directed at the 103 rejection and thus, will be addressed later. However, the examiner wishes to point out that the element 82 of figure 14c, as disclosed in the specification, is not a paintbrush holder; element 82 is the top view of the brush.

On pages 8-9 of the appeal brief, appellant argues the 103 rejection; however, it is unclear what appellant’s argument is because appellant only cites selected passages of prior office actions without clearly setting forth the argument. To the best of the examiner’s determination, appellant appears to argue that the prior art does not disclose the shape claimed and a change in shape is not obvious. The examiner maintains her position that both the claimed product and the prior art product differs in shape and to move from one conventional shape to another conventional shape would have been obvious to one skilled in the art. One of skill in the art knows that both paint can/brush and paint tray/roller are conventional shapes and the adaptation of the candy to either conventional shapes would have been an obvious variation; this is a variation in design choice with no alteration in function. There are many lollipop products commercially available and they come in many shapes, sizes and designs. Appellant’s argument would have been persuasive if there is no teaching of any lollipop product which simulates actual paint product; in the instant case, the Paint Pop product is a teaching of a candy product which simulates actual paint product. The question is whether or not it would have been obvious to move from one conventional paint product shape to another conventional shape and the answer is yes because both paint can/brush and paint tray/roller are well known shapes for paint products. The substitution of one shape for another depends on the design desired and would have been obvious to one skilled in the art. At the bottom of page 9, Appellant states the

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lid in the claim combination is not shown in the prior art primary reference and the reliance upon the secondary references to show a lid is improper. Appellant argues on page 10 that there is no suggestion in the Paint Pop product to add a lid and the product actually taught away from a lid as the flowable confectionery was contained in a separate packet. The fact that the confectionery is contained in a separate packet does not mean that a lid is not beneficial to the product or that a lid can not be added. The inclusion of a lid will prevent the packet and roller from falling out after the packaging paper is removed. The inclusion of a lid will enable one to continue consumption after a stop because the lid will prevent the confectionery from drying out, falling out or otherwise damage. The inclusion of a lid provide sanitary condition because the candy is protected from the environment. Thus, for the many known reasons, it would have been obvious to include a lid. Appellant argues the utility of the lid in the claimed combination is that the powder may be contained in the lid-enclosed container; it is not necessary to show adding an element for the same reason as claimed; it is only necessary to show why it would have been obvious to add such element. There are many reasons which would motivated one skilled in the art to include a lid in the Paint Pop product. If a lid is not included , not only will the powder falls out but the roller will also fall out. Additional, the lid will enable one to save the content if it is not used is one consumption, prevent the conten from drying out and prevent spilling. Thus, there are ample reasons to include a lid in the Paint Pop product. Applicant argues the powdered candy is contained in a separate packet at the time of sale. On page 11, appellant argues even if a lid is placed on the tray of the Paint Pop product, it does not contain the flowable confectionery which is contained within the sachet. The basis of appellant's argument is not understood. The claim does not require that the lid contain the flowable confectionery; the confectionery is contained in the can with the lid. In the Paint Pop product, the confectionery is contained in the tray and if a lid is



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included, the confectionery is contained in a lid-enclosed tray. Even though the powder is contained in a separate packet, it is placed in the tray because the packet is in the tray. The picture of the Paint Pop product clearly shows a tray containing the roller and the powdered packet. The claim does not exclude the sachet, as long as the confectionery is in the tray. The rejection does not take the position that the Paint Pop product is equivalent to the claimed product; the rejection is premised on the position that it would have been obvious to move from one conventional shape to another conventional shape. On pages 11-13, appellant cites the advantages and functions of a lid; the examiner does not doubt that having a lid is advantageous and that a lid provides specific functions. There are ample reasons set forth above for why one skilled in the art would be motivated to include a lid. Appellant contends it is cheaper to sell the product with the flowable confectionery contained in a can with a removable lid than it is to place the flowable confectionery in a separate packet. Appellant has not shown that it is cheaper for the flowable confectionery to be contained in a can with a removable lid. Appellant does not have evidence to show that it is cheaper. Appellant argues it is only common sense that if a cellophane bag or sachet is not required in one product, and is required in another, the latter will be more expensive even if it is only fractions of a penny. There are many factors involved in the cost of production of a product and appellant has not made a side by side comparison of the cost of the two products to make the argument that one is cheaper to produce than the other. On page 13 of the appeal brief, appellant argues the paint tray of the Paint Pop product is a lightweight plastic with very little structural strength and the lid of the paint tray would hardly be argued as being engagement means for the lid as recited in the claim. It would have been readily apparent to one skilled in the art that if a lid is to be included in the Paint Pop product, it would have to be made with a material that is compatible with the tray and can be fitted on the tray snugly. What would be the purpose for having a lid if it can not be fitted over

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the tray? On page 13 of the appeal brief, appellant argues the packet of the Paint Pop has been eliminated. It is again stressed that the flowable material is inside the tray and that the confectionery is extractable by wetting and dipping because the candy powder is emptied into the paint tray. Applicant argues the packet is excluded by virtue of the fact that it does not positively recite a packet as the container for the confectionery powder. The fact that the claim does not positively recite an element does not mean that element is excluded.

On page 14, appellant argues the claimed product is more hygienic because it is more likely that a child will spill some of the flowable confectionery in the process of opening the package or in pouring it into the tray and it is not likely that the child will simply discard the spilled material but will attempt to recover it by scraping it up and putting it into the container. This is speculation on what will likely happen or not happen. The same speculation can be made against the claimed product because a child can spill the whole container of the flowable confectionery while opening the lid and also can attempt to scrap up the spilled material backed into the can. Appellant argues there are not merely differences in structure but also differences in functions between the prior art and the claimed product. The differences in structure between the claimed product and the prior art product reside in the shape of the product and to move from one conventional shape to another conventional shape would have been obvious to one skilled in the art. It is unclear what appellant views as differences in functions; each of the differences pointed out by appellant has been addressed above. Appellant states a brush holder is not shown. As set forth above, the specification does not disclose a paint brush holder attached to the container. The brush is attached through the packaging and in the Paint Pop product, the roller is attached to the tray through packaging.

On pages 16-19 of the appeal brief, appellant makes reference to the declarations as evidence of secondary factors.

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With respect to Mr. Baker declaration, it is not found persuasive to demonstrate commercial success. The declaration states in about 3 years the marketed sales of the Paint Shop product have been in excess of 50 million. A sale figure does not demonstrate commercial success. The sale of a product is influenced by many factors such as the economy, populational growth, advertisement, marketing strategies etc... There is no evidence showing that the sale is resulting solely from the product. Also, it is not known what this sale figure means. Appellant states Mr. Baker points out that sales have gone from zero dollars to 50,000,000 in a period of approximately three years. However, the declaration does not show how this sale figure is achieved. It is not known if such increase in sale is due to heavy promotion or advertisement, shift in advertising, consumption by purchaser or any extraneous factors. Appellant must show that the claimed features were responsible for the commercial success of an article; merely showing that there was commercial success of an article which embodied the invention is not sufficient. Gross sale figures do not show commercial success absent evidence as to market share, or as to the time period during which the product was sold or as to what sale would normally be expected in the market. The declaration also states the Paint Shop product received an award in 1999. How does this award relate to commercial success? It is not known the criteria in which the award is given. There is no connection between the award and commercial success. The declaration states that Paint Shop is a highly successful product. This statement is an opinion and is not evidence showing commercial success. In sum, there is no evidence in the declaration which shows commercial success.

With respect to Mr. Moskowitz's declaration, it is not found to be persuasive. The declaration states the Roller Pop product was awkward to lick because the plastic handle was in the way; by contrast the paint brush candy sucker in the Paint Shop product can be easily licked on a side and access to the candy is not

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impeded by the plastic brush handle. This statement is not backed up by evidence. Were the two products tested on different populations to arrive at this conclusion. If the Roller Pop is awkward to lick because of the handle, the same problem would be encountered in the Paint Shop product because it also has a plastic handle. Access to the candy in the Roller Pop product is not impeded by the handle because the handle is only on one end of the candy. If one wants to lick all the sides of the candy, it is only necessary to change the orientation of the candy part. The declaration states that if the powder is not consumed, it could easily be spilled from the tray. This problem is the motivation for why it would have been obvious to add a lid to the Paint Pop product. The declaration also states that in several instances and also due to manufacturing difficulties, once the painter roller sucker was licked, it would then not roll properly or at all. It is not known what is covered under the phrase "several instances" but it is apparent that the problem stated does not occur all the time. It is not known what happened in those instances to cause the sucker not to roll properly. There is no evidence presented to show that the problem is due to the structure of the product. With respect to the statement about being consumed in one eating event, such problem is also the motivation for adding a lid to the Paint Pop product as suggested by the actual paint product references. The declarant states that it never occurred to him to put a lid on the Paint Pop product. The basis of the 103 rejection is what would have been obvious to one skilled in the art at the time of the invention. Knowing the problem of spilling, drying out etc. and with the teaching of a lid to cover a tray to prevent spilling and drying out and to enable to be used again after a time, it would have been obvious to one skilled in the art to put a lid on the Paint Pop product. Even without the teaching of a lid, it would have been obvious to use common sense to cover the tray with a covering or a piece of plastic if the powder is not all consumed and one wants to consume it again at a later time. Appellant states Mr. Moskowitz characterizes the success of the Roller Pop product as "

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mild” and only for a limited period of time. The declaration does not elaborate on what is considered “mild success”; there was no sale figure or any parameters to define “ mild success” . It is not seen how this declaration is evidence of commercial success of the claimed product.

With respect to Mr. Taylor declaration, there is no showing of evidence to demonstrate commercial success. The sale figures by themselves are not evident of commercial success because as stated above the sale of the product is based on many factors. In order to show commercial success, applicant needs to show that the success results solely because of the product and nothing else. The declaration states LolliPop Paint Shop outsold many other candies. The statement alone is not evidence of commercial success. It is not known if other factors such as marketing strategies, advertisement, populational changes, economy etc. are involved. Mr. Taylor states the success of a candy product is evidenced by the extent of distribution through various classes of trade. Many places of distribution of the product does not mean commercial success. There is no link between extent of distribution and commercial success. The extent of distribution might be part of the marketing strategy for the product. In fact, the extent of distribution might contribute to the reason why the Paint Shop outsold other candies. In which case, this is not evidence of commercial success because the sale is not due solely to the product but due to the way the product is marketed.

In summary, the declarations are found to persuasive as evidence of commercial success.

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For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,


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